

## **REMARKS**

Applicant has carefully reviewed the Office Action mailed April 14, 2008, prior to preparing this paper. Currently claims 1-9, 11, 13-16, 18-26 and 30 are pending in the application, wherein claims 1-4, 8, 9, 11, 13-16, 19, 22-26 and 30 have been rejected and claims 5-7, 18, 20 and 21 have been withdrawn from consideration. Claims 1, 13, and 22 have been amended and claim 25 has been canceled with this paper. Support for the amendments may be found in the specification, claims and drawings as filed. No new matter has been added. Favorable consideration of the above amendments and following remarks is respectfully requested.

### **Drawings**

The drawings were objected to in the Office Action of the Examiner dated April 17, 2007. Appropriate amendments were made in the Response filed on July 16, 2007. The Examiner has since not indicated the drawings have been accepted. It is respectfully requested that with the next Action, the Examiner indicate the status of the drawings.

### **Claim Objections**

Claims 1-4, 8, 9, and 11 have been objected to because of informalities as indicated in the Office Action. Appropriate amendments to the claims have been made with this paper. Thus, it is believed these objections have been overcome. Withdrawal of the objection is respectfully requested.

### **Claim Rejections Under §102**

Claims 1, 8 and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Palermo et al., U.S. Patent No. 5,769,796. Applicant respectfully traverses this rejection. Claim 1 has been amended to recite:

A guidewire comprising:  
an elongated inner core member including a proximal section and a distal section, the distal section including a proximal portion and a distal portion;  
an elongated reinforcing member having a proximal end and a distal end,  
the elongated reinforcing member disposed about the proximal portion of the

distal section such that the distal portion of the distal section is free of the reinforcing member; and

an outer coil member having a proximal end and a distal end, the outer coil member disposed about the distal section of the core member, there being no intervening layer of material between the distal portion of the distal section of the inner core member and the outer coil member; and

the outer coil member located exterior of the elongated reinforcing member such that there exists an unoccupied space between the entire perimeter of the elongated reinforcing member and the outer coil member;

wherein the proximal end of the outer coil member is located proximal of the proximal end of the elongated reinforcing member.

MPEP 2131 states that, in order to anticipate a claim, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." Applicant respectfully asserts that Palermo et al. do not disclose that which is currently claimed in claim 1. For instance, Palermo et al. fail to teach a reinforcing member in which there is an unoccupied space between the entire perimeter of the elongated reinforcing member and the outer coil member, as is currently claimed. Palermo et al. teach a solder joint (128) between the inner and outer members, which would not leave an unoccupied space between the inner and outer members. For at least these reasons, Applicant asserts that claim 1 is now in condition for allowance. Claims 8 and 9, which depend from claim 1, are also believed to be in condition for allowance. Withdrawal of the rejection is respectfully requested.

### **Claim Rejections Under §103**

Claims 2-4, 13-15, and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Palermo et al., U.S. Patent No. 5,769,796, in view of O'Connor et al., U.S. Patent No. 6,887,235. Applicant respectfully traverses this rejection.

Claims 2-4 depend from claim 1. As discussed above, Palermo et al. fail to teach each and every limitation of claim 1. O'Connor et al. fail to remedy the shortcomings of Palermo et al. Namely, O'Connor et al. do not teach a reinforcing member in which there is an unoccupied space between the entire perimeter of the elongated reinforcing member and the outer coil member, as is currently claimed. The outer sheath 24 of the catheter of O'Connor is disposed directly over the reinforcing tube 18. Withdrawal of the rejection is respectfully requested.

Independent claim 13, as amended, recites:

A guidewire comprising:

an elongated inner core member, the core member having a proximal region and a distal region with at least a portion of the distal region including stainless steel, the distal region having a proximal section and a distal section;

an elongated tubular reinforcing member including a nickel-titanium alloy disposed about the inner core member, the reinforcing member having a proximal end and a distal end, wherein the distal end terminates proximal of the distal section of the distal region of the core member;

wherein the reinforcing member comprises a tube having at least one cut or groove defined therein; and

an outer coil member having a proximal end and a distal end, the outer coil member disposed over the distal section of the core member and at least a portion of the reinforcing member; and

the outer coil member located exterior of the elongated reinforcing member such that there exists an unoccupied space between the entire perimeter of the elongated reinforcing member and the outer coil member;

wherein the proximal end of the outer coil member is located proximal of the proximal end of the reinforcing member.

As can be seen, claim 13 is directed to a guidewire having an elongated inner core, an elongated tubular reinforcing member, and an outer coil member. The outer coil member is located exterior of the elongated reinforcing member such that there exists an unoccupied space between the entire perimeter of the elongated reinforcing member and the outer coil member. Neither reference, either separately or in combination, disclose or suggest these claimed features. For at least the reasons discussed above with respect to claim 1, Palermo et al. do not appear to teach or suggest an unoccupied space between the reinforcing member and the outer coil. Palermo et al. teach a solder joint (128) between the inner and outer members, which would not leave an unoccupied space between the inner and outer members. Further, O'Connor et al appear to teach the outer sheath 24 of the catheter is disposed directly over the reinforcing tube 18. Thus, O'Connor et al. do not appear to teach or suggest the outer coil member is located exterior of the elongated reinforcing member such that there exists an unoccupied space between the entire perimeter of the elongated reinforcing member and the outer coil member.

Further, there appears to be no motivation, suggestion, or other reason for one of ordinary skill in the art to modify the device of Palermo et al. or O'Connor et al. to arrive at the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested. For similar reasons and others, Applicant submits that claims 14-15 and 19 are also in condition for

allowance as they depend from claim 13 and add significant limitations to further distinguish them from the prior art.

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Palermo et al., U.S. Patent No. 5,769,796, in view of Urick et al., U.S. Patent No. 5,666,969. Applicant respectfully traverses this rejection.

For at least the reasons discussed above with respect to claim 1, Palermo et al. do not appear to teach or suggest an unoccupied space between the reinforcing member and the outer coil. Palermo et al. teach a solder joint (128) between the inner and outer members, which would not leave an unoccupied space between the inner and outer members. Urick et al. do not appear to teach what Palermo et al. lack. Thus, even if one were to combine Palermo et al. and Urick et al., one would not arrive at the device as claimed. Furthermore, there is no motivation, suggestion or other reason for one of ordinary skill in the art to modify Palermo et al. or Urick et al. to achieve the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 16, 22-26, and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Palermo et al., U.S. Patent No. 5,769,796, in view of O'Connor et al., U.S. Patent No. 6,887,235., further in view of Urick et al., U.S. Patent No. 5,666,969. Applicant respectfully traverses this rejection.

Claim 16 depend from claim 13. For at least the reasons discussed above with respect to claim 13, Palermo et al. or O'Connor et al. do not appear to teach or suggest either separately or in combination an unoccupied space between the reinforcing member and the outer coil. Urick et al. do not appear to teach what Palermo et al. and O'Connor et al. lack. Thus, even if one were to combine Palermo et al., O'Connor et al., and Urick et al., one would not arrive at the device as claimed. Furthermore, there is no motivation, suggestion or other reason for one of ordinary skill in the art to modify Palermo et al., O'Connor et al., or Urick et al. to achieve the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested.

Independent claim 22, as amended, recites:

A guidewire comprising:  
an elongated inner core member including stainless steel, the inner core member including a proximal portion having a first cross-sectional area, an intermediate portion having a second cross-sectional area, wherein the second

cross-sectional area is less than the first cross-sectional area, and a distal portion having a ribbon profile;

an elongated tubular member including a nickel-titanium alloy, the tubular member having a proximal end and a distal end, the tubular member being disposed about the intermediate portion of the inner core member;

wherein the elongated tubular member comprises a tube having at least one cut or groove defined therein; and

a coil tip including stainless steel, the coil tip having a proximal end and a distal end, the coil tip extending over the distal portion of the inner core member and the tubular member;

wherein the proximal end of the coil tip is located proximal of the proximal end of the tubular member; and

the coil tip has an outside diameter, wherein the outside diameter of the coil tip is substantially equal to a diameter of the proximal portion of the core member configured to create a smooth transition from the core member to the coil tip.

As can be seen, claim 22 is directed to a guidewire having an elongated inner core, an elongated tubular reinforcing member, and a coil tip. The coil tip has an outside diameter, substantially equal to a diameter of the proximal portion of the core member. None of the references, either separately or in combination, disclose or suggest these claimed features.

Palermo et al. appear to teach a wire coil 112 disposed over a tapered portion 122 of the guidewire. Wire coil 112 appears to be secured to the guidewire using a polymer adhesive 136. This appears to create an abrupt transition from a smaller diameter guidewire to a larger diameter wire coil 112. Thus, Palermo et al. cannot be considered as teaching or suggesting the limitation, “wherein the outside diameter of the coil tip is substantially equal to a diameter of the proximal portion of the core member configured to create a smooth transition from the core member to the coil tip.”

O'Connor et al. do not appear to teach that which Palermo et al. lack. The outer sheath 24 of the catheter of O'Connor appears to be disposed directly over the reinforcing tube 18. Thus, O'Connor et al. cannot be considered as teaching or suggesting the limitation, “wherein the outside diameter of the coil tip is substantially equal to a diameter of the proximal portion of the core member configured to create a smooth transition from the core member to the coil tip.”

Urick et al. do not appear to teach that which Palermo et al. and O'Connor et al. lack. Urick et al. appear to teach a coil 34 disposed over a core wire 10. Coil 34 appears to be attached to the core wire 32 at the proximal end 36 with a spaced winding coil. There appears to

be an abrupt transition in the diameters at the point of attachment. Thus Urick et al. cannot be considered as teaching or suggesting the limitation, "wherein the outside diameter of the coil tip is substantially equal to a diameter of the proximal portion of the core member configured to create a smooth transition from the core member to the coil tip."

For at least these reasons, Palermo et al., O'Connor et al., and Urick et al. either separately or in combination do not appear so teach or suggest the limitation, "wherein the outside diameter of the coil tip is substantially equal to a diameter of the proximal portion of the core member configured to create a smooth transition from the core member to the coil tip." Thus, even if one were to combine Palermo et al., O'Connor et al., and Urick et al., one would not arrive at the device as claimed. Furthermore, there is no motivation, suggestion or other reason for one of ordinary skill in the art to modify Palermo et al., O'Connor et al., or Urick et al. to achieve the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested.

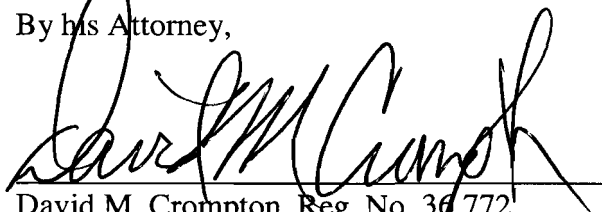
For similar reasons and others, Applicant submits that claims 23-26 and 30 are also in condition for allowance as they depend from claim 22 and add significant limitations to further distinguish them from the prior art.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Alan Eskuri

By his Attorney,



David M. Crompton, Reg. No. 36,772  
CROMPTON, SEAGER & TUHTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349

Date: \_\_\_\_\_

7/10/08